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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,341	03/12/2004	Marc Husemann	tesa 1605-WCG	9929
27386	7590	11/20/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/800,341	Applicant(s) HUSEMANN ET AL.	
	Examiner William K. Cheung	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of applicants' argument filed in the Appeal Brief of September 15, 2006, the rejection of Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (US Pub. 2003/0120101 A1) is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1713

3. Claims 1-5, 7-9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) for the reasons adequately set forth from paragraph 2 of the office action of March 17, 2006.

Massow et al. disclose an acrylate-based hotmelt pressure sensitive adhesive comprising 55 to 98% by weight of acrylic alkyl ester (column 3, line 42-46) wherein the general formula of alkyl esters of acrylic acid or methacrylic acid is identical to that indicated in Claim 1 (column 3, line 28-40). It is noted that the general formula in the prior art is wrong and it should be $\text{CH}_2=\text{C}(\text{R})-\text{COOR}'$ according to the description of Massow et al. for the acrylate alkyl ester appears to read on the polyacrylate component limitations in applicants claims 1 and 6-9. Massow et al. also disclose that the adhesive composition can contain additives and auxiliaries, such as antioxidants, sensitizers for UV crosslinking, fillers (for example 0.1 – 50%), resins or resin systems (column 4, line 36-41). Regarding the claimed “a weight average molecular weight Mw of not more than 500,000 g/mol”, applicants must recognize that Massow et al. (col. 3, line 27-58) clearly disclose a mixture of monomers or oligomers, and the use of “regulator” to prevent the adhesive system from building high molecular weight polymers (col. 5, line 5-13), the examiner has a reasonable basis that the claimed “weight average molecular weight Mw of not more than 500,000 g/mol” is inherently possessed in Massow et al., since the molecular weight of monomers (or oligomers after radiation on a substrate) should be substantially lower than the weight average molecular weight of 500,000 g/mol. Massow

Art Unit: 1713

et al. (col. 6, line 33) disclose the incorporation of terpenephenolic resin, which meets applicants' claim 16.

With regard to claim 5, as discussed above, in view that the adhesive composition prepared by Massow et al. is substantially identical to the composition as claimed, the examiner has a reasonable basis to believe that the claimed "shrinkback" properties are inherently possessed in Massow et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to the applicant to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

The difference between Massow et al. and the invention of Claims 1-5, 7-9, 16 and 17 is that Massow et al. do not disclose the an adhesive composition comprising calcium carbonate.

Guldbrandsen et al. (col. 4, line 15-67) disclose a pressure-sensitive adhesive composition, comprising low molecular weight mass of acrylic hotmelts, that is very similar to the composition of Massow et al. Guldbrandsen et al. also disclose additives such as, aging inhibitors, crosslinkers, plasticizers, accelerators (column 4, line 25-28) that are suitable in a hotmelt pressure sensitive adhesive formulation as required by applicants' claim 17. In view of substantially identical endeavors of developing low molecular weight acrylic based hot melt adhesive, motivated by the expectation of

Art Unit: 1713

success of developing a radiation curable adhesive system that can be regulated by way of temperature of the coated roller (col. 4, line 12-14), it would be apparent to one of ordinary skill in art to recognize that functional equivalence of chalk (which compositionally known as calcium carbonate) with a list of other fillers that are also taught in Massow et al., and would have been obvious to one of ordinary skill in art to incorporate the chalk or calcium carbonate teachings of Guldransen et al. into the pressure-sensitive adhesive composition of Massow et al. to obtain the invention of claims 1-5, 7-9, 16 and 17.

Regarding the claimed "substantially free of carboxyl or hydroxyl groups" of claim 1, applicants must recognize that Massow et al. (col. 4, line 17-25) clearly teach the non-preference of either the carboxyl groups or their corresponding anhydride groups are equally suitable. Therefore, Massow et al. also teach adhesive compositions that do not require a carboxyl or a hydroxyl group to work. Therefore, the examiner has a reasonable basis that the adhesive teachings in Massow et al. generically also include adhesive composition that are "substantially free of carboxyl or hydroxyl groups" as required by applicants' claim 1.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571)

Art Unit: 1713

272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

WILLIAM K. CHEUNG
PRIMARY EXAMINER

November 16, 2006